

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPEAL BRIEF

Application No.: 09/609147

Customer No.: 22927

Attorney Docket No.: 99-110

Date Filed: June 30, 2000

Title: METHOD AND APPARATUS FOR COMPENSATING
PARTICIPATION IN MARKETING RESEARCH

Appellants: Walker et al.

Group Art Unit: 3622

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**BOARD OF PATENT APPEALS
AND INTERFERENCES**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants submit this Appeal Brief following the Examiner's Office Action
mailed January 4, 2006 (Paper No. / Mail Date 20051226).

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REAL PARTY IN INTEREST

The present application is assigned to Walker Digital, LLC, 2 High Ridge Park, Stamford, CT 06905.

RELATED APPEALS AND INTERFERENCES

Appellants, Appellants' legal representative and Appellants' assignee know of no interferences or appeals that will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 75-108 are pending, rejected, and are being appealed.

Claims 1-74 are canceled.

STATUS OF AMENDMENTS

No amendments have been filed subsequent to the Office Action mailed January 4, 2006.

SUMMARY OF CLAIMED SUBJECT MATTER

Claims 75, 107, and 108 are independent.

Concise explanations of the independent claims are provided below. As required by 37 C.F.R. § 41.37(c)(1)(v), reference is made to the Specification. Any such reference and / or accompanying explanation:

(i) is by way of example of the claimed subject matter only and is not a comprehensive description of the scope of the independent claim being discussed, nor a comprehensive listing of support in the specification for the independent claim being discussed;

(ii) might be potentially useful in clarifying the particular subject matter of the particular independent claim being discussed (and not other claims or “the invention” as a whole), unless explicitly stated otherwise; and

(iii) is not to be considered as broadening or narrowing or otherwise affecting the interpretation of any claim or part of a claim, unless explicitly stated otherwise.

Additionally, any explanation or reference to the specification which refers to more than one claim, or is utilized in the explanation of more than one claim, is not to be considered as broadening or narrowing or otherwise affecting the interpretation of any claim or part of a claim, and is not to be considered as indicating any equivalence of any claims or parts of a claim.

1. Independent Claim 75

Independent Claim 75 recites a method, including a step of determining a gambling history of a player. For some examples, see Specification, page 19, line 22 to page 20, line 23; page 4, lines 16-26; FIG. 12 (1204); FIG. 7 (302B); and accompanying text.

The method also includes selecting the player to receive a survey question based on the gambling history. For some examples, see Specification, page 21, line 21 to page 23, line 23; FIG. 12 (1208); and accompanying text. The method also includes transmitting the survey question to the player via a slot machine. For some examples, see Specification, page 23, line 15 to page 24, line 9; FIG. 12 (1210); FIG. 8 (302C) and accompanying text.

The method also includes receiving a response of the player to the survey question. For some examples, see Specification, page 24, line 11 to page 25, line 2; FIG. 12 (1212); and accompanying text. The method also includes determining, by a processing device, compensation for the response, and after receiving the response, transmitting a signal to the slot machine to provide the determined compensation to the player. For some examples, see Specification, page 25, line 4 to page 26, line 16; page 5, lines 4-9; page 28, line 1 to page 29, line 4; FIG. 12 (1214); FIG. 6 (302A); and accompanying text.

2. Independent Claims 107 and 108

Independent Claim 107 recites a computer readable medium configured to direct a processor to perform a method substantially similar to that of Claim 75, discussed above. Independent Claim 108 recites an apparatus comprising the computer readable medium described in Claim 07.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Section 103(a)—Raven + Plainfield

Claims 75, 76, 79-81, 99, 102, 103, and 106-108 stand rejected under 35 U.S.C. 103(a) as being obvious in view of asserted subject matter allegedly supported by evidence from:

U.S. Patent No. 5,429,361 issued to Raven et al. ("Raven"); and

U.S. Patent No. 5,893,075 issued to Plainfield et al. ("Plainfield").

2. Section 103(a)—Raven + Plainfield + Examiner's subjective belief

Claims 82-97, 100, 101, and 105 stand rejected under 35 U.S.C. 103(a) as being obvious in view of:

(i) asserted subject matter allegedly supported by evidence from:

Raven, and

Plainfield; and

(ii) asserted subject matter

(i) that is not supported by substantial evidence of record,

(ii) that the Examiner now acknowledges is not supported by evidence of record, and

(iii) that the Examiner now explicitly states does not have to be supported by any evidence of record.

3. Section 103(a)—Raven + Plainfield + Liverance

Claims 76, 77, 78, 84, 102, and 103 stand rejected under 35 U.S.C. 103(a) as being obvious in view of asserted subject matter allegedly supported by evidence from:

Raven,

Plainfield, and

U.S. Patent No. 5,971,850 issued to Liverance (“Liverance”).

Appellants note that Claims 76, 84, 102 and 103 are rejected under Section 103 on two separate grounds.

4. Section 103(a)—Raven + Plainfield + Paige

Claim 98 stands rejected under 35 U.S.C. 103(a) as being obvious in view of asserted subject matter allegedly supported by evidence from:

Raven,

Plainfield, and

U.S. Patent No. 5,941,772 issued to Paige (“Paige”).

5. Section 103(a)—Raven + Plainfield + Dyer

Claim 104 stands rejected under 35 U.S.C. 103(a) as being obvious in view of asserted subject matter allegedly supported by evidence from:

Raven,

Plainfield, and

U.S. Patent No. 5,090,734 issued to Dyer (“Dyer”).

ARGUMENT

1. Introduction

In the arguments provided, limitations of the claims are indicated in *italics* and the references of record are indicated by underlining.

In separate arguments of patentability for separate claims (or groups of claims), Appellants have, where possible, referred to prior arguments to avoid undue repetition.

In the arguments below, Appellants may refer to:

- Fifth Office Action: Non-Final Office Action mailed January 4, 2006
- Appellants' Fourth Response: Appellants' Amendment and Response filed October 3, 2005
- Fourth Office Action: Non-Final Office Action mailed June 29, 2005
- Appellants' Third Response: Appellants' Amendment and Response mailed March 21, 2005
- Third Office Action: Non-Final Office Action mailed November 19, 2004

2. Section 103(a)—Raven + Plainfield

Claims 75, 76, 79-81, 99, 102, 103, and 106-108 stand rejected under 35 U.S.C. 103(a) as being obvious in view of asserted subject matter allegedly supported by evidence from:

U.S. Patent No. 5,429,361 issued to Raven et al. (“Raven”); and

U.S. Patent No. 5,893,075 issued to Plainfield et al. (“Plainfield”).

The Examiner’s Section 103(a) rejections based on the above grounds are argued separately for the following Groups of appealed claims:

Group A. Claims 75, 81, and 106-108

Group B. Claims 76 and 99

Group C. Claims 102 and 103

Group D. Claims 79 and 80

The claims in the different designated groups do not stand and fall together. Each of the groups is addressed below under a separate subheading identifying the respective claim(s) by number.

The following section on Applicable Law is equally applicable to the arguments provided for all of the rejections under Section 103(a).

2.1. Applicable Law

2.1.1. Prima facie burden

If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent. In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

2.1.2. Substantial evidence required for all factual findings

All findings of fact by the U.S. Patent and Trademark Office must be supported by substantial evidence within the record. In re Gartside, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000).

The Supreme Court has described "substantial evidence" in the following manner:

substantial evidence is more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion. . . . Mere uncorroborated hearsay or rumor does not constitute substantial evidence.

Consolidated Edison Co. v. NLRB, 305 U.S. 197, 229, 83 L. Ed. 126, 59 S. Ct. 206 (1938); See also, Dickinson v. Zurko, 527 U.S. 150, 162, 50 U.S.P.Q.2D 1930, 144 L. Ed. 2d 143, 119 S. Ct. 1816 (1999) ("Zurko III").

"[R]eview under this standard involves an examination of the record as a whole, taking into consideration evidence that both justifies and detracts from the agency's decision." Universal Camera Corp. v. NLRB, 340 U.S. 474, 487-88, 95 L. Ed. 456, 71 S. Ct. 456 (1951); Zurko III, 527 U.S. at 162.

Deficiencies of cited references relied upon for rejection cannot be remedied by the Board's general conclusions about what is "basic knowledge" or "common sense." In re Zurko, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

In other words, the Board is not permitted to accept conclusory findings made by the Primary Examiner that are not supported by substantial evidence made of record.

2.1.3. Obviousness

The Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. In re Fritch, 972 F.2d 1260, 1265 (Fed. Cir. 1992). To reject claims in an application under section 103, an examiner must

show an un rebutted *prima facie* case of obviousness. In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

The factual predicates underlying an obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art. In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998). The secondary considerations are also essential components of the obviousness determination. In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

When a rejection is based on a combination of references, the Examiner can satisfy the prima facie burden only by showing some objective evidence of a teaching leading to the purported combination of references. In re Fritch, 972 F.2d 1260, 1265 (Fed. Cir. 1992). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 5 U.S.P.Q.2d 1596, 837 F.2d 1071 (Fed. Cir. 1988); In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

Lacking a motivation to combine references, there is no prima facie case of obviousness. In re Rouffet, 149 F.3d 1350, 1358 (Fed. Cir. 1998); In re Grabiak, 226 U.S.P.Q. 870, 769 F.2d 729, 732 (Fed. Cir. 1985).

Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. In re Kotzab, 55 U.S.P.Q.2D 1313, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Findings of prior knowledge in the field of the invention must be supported by tangible teachings of reference materials, and the suggestion to combine references must not be derived by hindsight from knowledge of the invention itself. Cardiac Pacemakers v. St. Jude Medical 381

F.3d 1371, 1376, 72 U.S.P.Q.2d 1333, 1337 (Fed. Cir. 2004); Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1578-79, 42 U.S.P.Q.2d 1378, 1383 (Fed. Cir. 1997) ("However, **the record** must provide a teaching, suggestion, or reason to substitute computer-controlled valves for the system of hoses in the prior art. The absence of such a suggestion to combine is dispositive in an obviousness determination.") (emphasis added).

In Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q. 459 (1966), the Supreme Court established the test for consideration and determination of obviousness under 35 U.S.C. § 103. In Iron Grip Barbell Co. v. USA Sports Inc., the Federal Circuit explained how obviousness must be determined using the four-part Graham test:

we employ the four-part test set forth in Graham v. John Deere Co., 383 U.S. 1 (1966). This test requires us to examine

- (1) the scope and content of the prior art;
- (2) the level of ordinary skill in the art;
- (3) the differences between the claimed invention and the prior art; and
- (4) the objective evidence of nonobviousness. *Id.* at 17-18; see also 35 U.S.C. § 103 (2000).

392 F.3d 1317, 1320, 73 U.S.P.Q.2D (BNA) 1225 (Fed Cir. 2004) (emphasis added). U.S. Patent and Trademark Office policy is also to follow Graham. Accordingly, examiners should apply the test for patentability under 35 U.S.C. § 103 as set forth in Graham. M.P.E.P. § 2141 "35 U.S.C. 103; the Graham Factual Inquiries", p. 2100-120, 8th ed., Rev. 2 (May 2004). Accordingly, during examination the Examiner must conduct the four factual inquiries enunciated in Graham in determining obviousness of any claim.

A determination of the level of ordinary skill in the art is an integral part of the Graham analysis. Ruiz v. A.B. Chance Co., 234 F.3d 654, 666 (Fed. Cir. 2000)

(citing Custom Accessories, 807 F.2d at 962). Ascertaining a level of ordinary skill in the art is thus necessary. M.P.E.P. § 2141.03. See Ryko Mfg. Co. v. Nu-Star, Inc., 950 F.2d 714, 718 (Fed. Cir. 1991) (“Hence, the level of ordinary skill in the art is a factual question that must be resolved and considered.”) (emphasis added). Accordingly, it is necessary to determine who the “person of ordinary skill in the art” is before making a determination of obviousness.

Finally, during examination, claims are given their broadest reasonable interpretation consistent with the specification. In re Hyatt, 54 U.S.P.Q.2D 1664, 211 F.3d 1367 (Fed. Cir. 2000). The “PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.” In re Morris, 44 U.S.P.Q.2D 1023, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997).

2.2. Group A: Claims 75, 81-85, 87-93, 97, and 106-108

Group A includes Claims 75, 81-85, 87-93, 97, and 106-108.

Claim 75 is an independent method claim. Claims 81-85, 87-93, 97, and 106 depend from Claim 75. Claim 107 is independent and provides for a computer readable medium storing instructions configured to direct a processor to perform a method similar but not identical to Claim 75. Claim 108 is independent and provides for an apparatus comprising the computer-readable medium of Claim 107. Arguments presented below with respect to Claim 75 are equally applicable to the other claims of Group A.

Substantial evidence is required of all factual findings. In re Gartside, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000). Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group A is flawed because the Examiner has not made a *prima facie* case of obviousness.

The Examiner has failed even to make a finding as to the level of ordinary skill in the art, as required by Graham and the Manual for Patent Examining Procedure § 2141.03, much less support such a finding with substantial evidence.

The Examiner also has failed to provide substantial evidence that all of the features of Claim 75 were known at the time of invention. The Examiner has also failed to provide substantial evidence of a motivation to combine or modify the asserted subject matter to provide for such features.

Further, even if the evidence of record and / or a defined level of ordinary skill supported the Examiner's purported motivation to combine asserted subject matter in the manner suggested, the resulting combination would fail to teach or suggest all of the specific features of Claim 75. Any combination or modification of the references relied upon would fail to teach or suggest Claim 75.

There is no *prima facie* showing of obviousness of any claim of Group A. At least one limitation is not disclosed or suggested by the cited references. Accordingly, the Examiner has not presented a *prima facie* case of obviousness of the claims. Further, no claim of Group A is obvious in light of the evidence relied upon by the Examiner.

2.2.1. The Examiner has Failed to Conduct the Required Graham Inquiries

Appellants have carefully reviewed the Section 103 rejections of all pending claims (including the claims of Group A) in the present Office Action to determine compliance with the Graham requirements. Appellants respectfully submit that the Examiner has not followed Graham with respect to any rejection under Section 103. Accordingly, this argument is equally applicable to all of the groups of claims and grounds for rejection discussed in this paper.

Specifically, the Examiner has neither

- a) defined a level of ordinary skill in the art, nor
- b) clearly indicated any evidence in support of such a finding.

Such findings are necessary in assessing obviousness. M.P.E.P. § 2141.03; Iron Barbell, 392 F.3d 1317; Ryko Mfg., 950 F.2d at 718.

The Examiner is openly dismissive of these requirements. The Examiner states, contrary to law, that there is no requirement to determine the qualities of one of ordinary skill in the art in order to perform an analysis for non-obviousness. Nonetheless, the Examiner simply asserts: “Suffice it to say that the inventors of the applied art represent the type of skill level considered to be ordinary.” [Fifth Office Action, page 6]. The Examiner, however, does not discuss whatever he may know about the education or training of those inventors, their approach to problem solving, etc., that would inform the determination of the ordinary skill in the art, and in fact has not made any findings of the skill level of those individuals.

It is possible that the Examiner intended to indicate that the level of ordinary skill that the Examiner has drawn upon in determining obviousness is defined by what is described in the cited references. If that is the case, then the Examiner has failed to establish a *prima facie* case of obviousness, as those references do not provide objective evidence of any specific or common knowledge of one of ordinary skill in the art that would support the Examiner's asserted motivations to modify the Raven system.

The Examiner asserts:

Applicant argues that examiner has not followed procedural requirements in making the rejections. Examiner disagrees and believes that the rejections are properly formed. In particular, although the examiner must form conclusions based upon one of ordinary skill, he need not explicitly describe, define, or characterize such a person.

[Fifth Office Action, page 6 (emphasis)].

The contradiction in the Examiner's approach to this issue is apparent from the underlined sentence. Although the Examiner acknowledges (at least nominally) the requirement to analyze obviousness from an objective viewpoint, the Examiner does not believe it is necessary to determine what that objective viewpoint actually is. Appellants cannot resolve this contradictory statement, which undermines all of the Examiner's Section 103(a) rejections.

As a result of the failure to resolve and consider the level of ordinary skill, the Examiner

(i) cannot have determined the scope and content of the prior art objectively, i.e., from the point of view of the hypothetical person having ordinary skill in the art at the time of invention, and thus

(ii) cannot have determined the differences between the cited references and the claims objectively, and also

(iii) cannot have determined objectively some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

As the Examiner has failed to conduct the required Graham factual inquiries, the Examiner cannot factually support any *prima facie* conclusion of obviousness with respect to any pending claim.

To the contrary, because the level of ordinary skill in the art was not defined and there is no evidence of record that the Examiner's findings are objective, the record indicates only that the rejected claims were found to be obvious (i) to the Examiner (who has the benefit of Appellants' disclosure), (ii) at the time the Fifth Office Action was written.

Examiner Declines to Clarify the Authoritative Basis for Refusal to Resolve Level of Ordinary Skill

It is still not clear to Appellants, however, whether the Examiner disagrees with (i) Appellants' discussion of the case law, (ii) Appellants' assessment of the Examiner's failure to meet the standards set by that case law, or both. Appellants requested that the Examiner (i) clarify for the record the Examiner's understanding of the cited case law; (ii) identify where in the record (if at all), the Examiner has made a finding of a level of ordinary skill in the art; and (iii) indicate the objective evidence of record on which that finding of level of ordinary skill (if any has been made) is based. The Examiner denied the opportunity to clarify the basis on which he has not followed the relevant case law or the MPEP.

**2.2.2. The References Do Not Disclose All the Limitations of
Group A**

Appellants respectfully submit that none of the claims of Group A (Claims 75, 81, and 106-108) is obvious in light of the evidence cited (Raven and Plainfield), either alone or in combination.

First, no combination of the subject matter described in Raven and Plainfield teaches or suggests all of the features of the independent claims. Second, there is no suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to modify or to combine the cited references to provide for all of the claimed features of Group A. The Examiner has failed to properly support, with objective and substantial evidence of record, the findings on which the rejection is based, and thus has failed to establish a prima facie case of obviousness.

The Raven and Plainfield references do not provide any evidence of any of the following features:

selecting the player to receive a survey question based on the (determined) gambling history (of the player),
transmitting the survey question to the player via a slot machine, or
providing determined compensation for a response to a survey question to the player via a slot machine.

The Examiner has not provided evidence that could support his finding that it was known or desirable to select a player to receive a survey question via a slot machine based on any information about the player (much less gambling history).

Examiner's Findings

As Appellants best understand the rejection, the Examiner implies that Raven teaches all of the features of the independent claims except “compensating the player for responding to a survey.” [Fifth Office Action, page 3].

The Examiner asserts: “Raven et al teaches programmed slot machines and networks which identify players and deliver promotional messages to the players [abstract].” [Fifth Office Action, page 2].

The Examiner also appears to find it relevant that Raven teaches that certain players may be designated as “special” based on “card data” and “treated differently” based on the amount the player is currently playing. [Fifth Office Action, page 2]. The Examiner implies that the description in Raven of how players are “treated differently” is evidence suggesting that it was known that “special players” would receive particular messages via a slot machine.

The Examiner further asserts: “Raven et al teaches that messages may request that the player respond interactively to enter requested information [5:63-64]....” [Fifth Office Action, page 3]. The Examiner further asserts:

As pointed out, Raven et al teaches identification of players as well as special treatment for certain players. It would have been obvious to one of ordinary skill at the time of the invention to have transmitted the disclosed interactive questions (taken to meet the broad language of a survey) to any desired individual or type of individual, including losing players.

[Fifth Office Action, page 6].

According to the Examiner: “Plainfield et al teaches surveying customers and rewarding the customers for responding as a means to create an incentive for participating in the marketing survey.” [Fifth Office Action, page 3].

Examiner’s Findings Not Supported by Substantial Evidence of Record

Appellants agree that Raven does not suggest compensating a selected player for responding to a survey.

Appellants disagree that Raven teaches all of the other features of any claim of Group A. Plainfield and Raven do not provide substantial evidence or any hint of transmitting survey or marketing questions to anyone via a slot machine.

With respect to the assertions as to what Raven teaches (Fifth Office Action, page 2), the Examiner does not correlate those assertions to any particular limitations of Group A and thus has failed to articulate any reasoned findings that any particular feature of the independent claims is taught by Raven. The Examiner has failed to establish a *prima facie* case of obviousness for at least this reason.

Contrary to the Examiner's assertion, Raven does not suggest that identifying a player has anything to do with delivering "promotional messages" (or any other type of message) to that identified player. Contrary to the Examiner's finding, there is no evidence in Raven of the desirability of selecting a particular player to receive a "promotional message."

Regardless, nothing in Raven remotely suggests either (i) providing messages or survey questions to a "special player," or (ii) that whether a player is "special" has anything to do with any information transmitted to the player via a slot machine. As pointed out by Appellants in Appellants' Fourth Response, Raven includes the following description:

It is another object of the invention to provide a signal to casino personnel to identify special players.

[Column 1, lines 65-67]; and

As previously mentioned, in the preferred embodiment a multi-color LED 36 is provided on the DMK 12. This LED 36 is lighted to indicate to casino personnel that a special player, e.g., a "high roller" or "VIP" is playing the game, and may be worthy of special treatment. The criteria for each color may be defined by the casino, and may be

based on data stored on the player's card as well as the amount being played.

[Column 9, lines 61-67]. Thus, contrary to the Examiner's assessment of Raven, the portions of Raven relied upon by the Examiner teach only the following: If a player is "special," signal to "casino personnel" that the player may be "worthy of special treatment."

Contrary to the Examiner's interpretation of the evidence, there is no discussion in Raven as to what "special treatment" by "casino personnel" may mean. There is also no suggestion in Raven (or otherwise in evidence) that "special treatment" by "casino personnel" has anything to do with whether any type of message is sent to that player via a slot machine. To the contrary, the cited passage suggests that "casino personnel," not the slot machine itself, will provide some "special treatment" to a player.

Accordingly, contrary to the Examiner's erroneous interpretation of the evidence he relies upon, there is no hint in Raven that a "special player," "card data," or "the amount being played by the player" has anything to do with selecting a player to receive any type of message via a slot machine, much less a survey question. As the Examiner's case for rejection explicitly rests on Raven as evidence of selecting the player to receive a survey question based on the (determined) gambling history (of the player), and transmitting the survey question to the player via a slot machine, the Examiner has failed to establish a prima facie case of obviousness based on substantial evidence of record. Nothing in Plainfield would remedy these failures of the Examiner's obviousness rejection.

Contrary to the Examiner's interpretation, the "player reply message" discussed at Column 5, lines 63-64 of Raven is not evidence suggesting (i) a survey question or (ii) that "requested information" relates in any way to a survey question. The Examiner, who has not defined the level of ordinary skill in the art,

does not indicate any factual findings supporting a conclusion that one having ordinary skill in the art would have interpreted “player reply message” or “requested information,” as that subject matter is discussed in Raven, as suggesting a survey question. Nonetheless, the Examiner simply concludes that “the disclosed interactive questions” is “taken to meet the broad language of a survey.”

In defense of this conclusion, the Examiner asserts: “it is the Examiner’s duty to interpret as broadly as reasonable the scope and meaning of claim language.” [Fifth Office Action, page 7]. Yet this is clearly how the Examiner has chosen to interpret subject matter in Raven; the record cannot support by objective evidence a finding that this would also have been the understanding of one of ordinary skill in the art. The “reasonableness” of the Examiner’s interpretation must be informed by both the level of ordinary skill and consistency with the disclosure. In re Hyatt, 54 U.S.P.Q.2D 1664, 211 F.3d 1367 (Fed. Cir. 2000). The Examiner has not indicated that those factors have been taken into account, and does not appear to have done so.

In fact, in Raven, the only “requested information” contemplated is either a “personal identification number (PIN)” or a “credit request.” The “PIN” and “credit request” are “transmitted to the system for verification.” [Column 8, lines 14-16; Column 10, lines 49-62]. Nothing in Raven or otherwise of record supports the Examiner’s finding that a prompt for a “PIN” or a “credit request” would have suggested a *survey question* to one of only ordinary skill in the art. There is no evidence of record that would support such a finding.

Further, nothing in Raven suggests that the “promotional messages” noted by the Examiner comprise any questions to a player, much less survey questions to which a player may respond. In fact, the “promotional messages” are distinguished in Raven from the “player reply messages.” This distinction would indicate that no “player reply” to a “promotional message” is provided or

suggested by the Raven system. [See Column 5, lines 57-63]. Even though evidence that detracts from the Examiner's interpretation must also be considered, the Examiner has not attempted to explain this clear distinction in the very evidence relied upon by the Examiner. Cf. Universal Camera Corp., 340 U.S. at 487-88.

Appellants submit that the Examiner has failed to establish with substantial evidence that the specific types of messages described in Raven suggest survey questions transmitted to players, or the desirability of providing survey questions via a slot machine. Only impermissible hindsight has led the Examiner to view the specific description in Raven of a "player reply message" as somehow suggesting a *survey question*. There is no evidence that the Examiner's generalized interpretation of the "player reply message" as "taken to meet the broad language of a survey" is consonant with how that type of message would have been understood by one of ordinary skill in the art at the time of the invention.

Plainfield suggests presenting survey questions to unidentified people (any passersby). Plainfield also does not suggest selecting any particular customer for a survey question, much less selecting a customer for a survey question based on information about the customer, much less gambling history. The evidence relied upon by the Examiner (Raven and Plainfield) cannot support such findings.

In fact, Plainfield is directed to getting information from customers about whom nothing is known for the purpose of establishing a mailing list. There is no hint of the desirability of discriminating (for any purpose) among customers based on information about the customers. For example, Plainfield teaches that an as-yet anonymous passerby is prompted for information on the same display screen at the same time the customer may be prompted with questions. Accordingly, there is nothing in Plainfield that would suggest that any determination is being made to transmit a question to a customer based on any information about the customer.

Plainfield describes a system that knows nothing about the passerby when the questions are presented.

Thus, there is no substantial evidence made of record that would support all of the Examiner's findings on which the rejection of Group A is based. Specifically, the evidence relied upon by the Examiner (Raven and Plainfield) does not support the Examiner's findings, and does not suggest any of the features of *selecting the player to receive a survey question based on the (determined) gambling history (of the player) or transmitting the survey question to the player via a slot machine*. Accordingly, there is no suggestion of *providing determined compensation for a response to a survey question to the player*, much less *transmitting a signal to a slot machine* to do so.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness for any of the claims of Group A (Claims 75, 81, and 106-108) and the evidence of record could not support any such rejection.

2.2.3. No motivation to combine the Raven and Plainfield references

Further, there is no evidence of record that it would have been obvious to combine Raven and Plainfield.

The references are not analogous. The Examiner has not made any finding as to the level of ordinary skill in the art, and thus cannot have established any reasoned finding as to why one of ordinary skill would have considered the casino gaming system of Raven to be somehow analogous or relevant to the mailing list system of Plainfield.

There is also no reasoned finding that it would have been desirable to present a survey question to a particular player at a slot machine, much less that the player may be selected based on information about his gambling history, much less

transmitting a signal to a slot machine to provide determined compensation to the player.

Examiner's Findings

The Examiner asserts:

It would have been obvious to one of ordinary skill at the time of the invention to have collected valuable marketing/profile/preference data from selected identified customers of Raven et al and to have rewarded them for participation. Plainfield et al teaches rewarding the customers with entry into contests (games of chance), etc and it would have been obvious to one of ordinary skill at the time of the invention to have rewarded the selected identified slot players with any incentive including points in the bonus points system disclosed by Raven et al.

[Fifth Office Action, page 3].

The Examiner further asserts that it would have been obvious to have selected any type of player, including losing players, for rewarding participation in a data gathering survey, so that the survey data could be collected for any type of targeted segment or so the reward for survey participation may be offered to those who are losing in order to keep their spirits up.

[Fifth Office Action, page 3].

Examiner's Findings Not Supported by Substantial Evidence of Record

The mere fact that “special players” are mentioned in Raven and presenting survey questions is mentioned in Plainfield is not substantial evidence of the asserted motivation(s).

Raven discusses a “bonus points system” that is related to play. Nothing in Raven suggests providing “points in the bonus points system” based on any other activity of the player.

As discussed above, the only teaching in Raven that may relate to “selected identified players” discusses signaling “casino personnel.” This has nothing to do with data collection.

Also, as discussed above, nothing in Plainfield suggests transmitting a survey question to a selected or identified person. To the contrary, Plainfield provides survey questions to unknown passersby.

Thus, there is no evidence of record (much less substantial evidence) that would support the Examiner’s assertion that one of ordinary skill in the art at the time of invention would have known that it was desirable to “select any type of player” to participate in a “data gathering survey,” much less select a player based on gaming history of the player, much less to transmit a survey question to such a selected player via a slot machine.

There is also no evidence in support of the Examiner’s finding that “the reward for survey participation may be offered to those who are losing in order to keep their spirits up” was a known motivation at the time of invention. The Examiner has made a conclusory, subjective, and impermissible finding using the benefit of Appellants’ disclosure, a finding that cannot be supported by any objective evidence of record.

Also, there is no finding of the level of ordinary skill, so there is no objective evidence that any teachings of Raven and Plainfield would have been deemed desirable by one of only ordinary skill before the time of invention.

No evidence of a motivation to provide for any of the specific features is provided of record. There is no suggestion that it would have been obvious to select a player for a survey question via a slot machine based on anything, much less based on gambling history. Further, as discussed above, even if a motivation were of record, the Examiner’s proposed combination would not provide for all of the features of any of the independent claims.

The Examiner has failed to establish a *prima facie* case of obviousness of Group A for at least these reasons. Accordingly, Appellants respectfully request reconsideration of the § 103(a) rejections of pending claims 75, 81-85, 87-93, 97, and 106-108.

2.3. Group B: Claims 76 and 99

Group B includes Claims 76 and 99.

Claims 76 and Claim 99 depend from independent Claim 75 and thus all of the arguments discussed above with respect to Claim 75 and Group A are equally applicable to Group B.

Substantial evidence is required of all factual findings. *In re Gartside*, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000). Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group B is flawed because the Examiner has not made a *prima facie* case of obviousness.

The Examiner has failed to provide substantial evidence that all of the features of Group B were known at the time of invention. The Examiner has also failed to provide substantial evidence of a motivation to combine or modify the asserted subject matter to provide for such a feature.

Further, even if the evidence of record supported the Examiner's purported motivation to combine asserted subject matter in the manner suggested, the resulting combination would fail to teach or suggest all of the specific features of Group B. Any combination or modification of the references relied upon would fail to teach or suggest Group B.

There is no *prima facie* showing of obviousness of any claim of Group B. At least one limitation is not disclosed or suggested by the cited references. Accordingly, the Examiner has not presented a *prima facie* case of obviousness of the claims. Further, no claim of Group B is obvious in light of the evidence relied upon by the Examiner.

In addition to the failures outlined above with respect to the rejection of Group A, the Raven and Plainfield references do not provide evidence that the following features were known:

- *determining an amount lost gambling by the player; and selecting the player based on the amount lost gambling*
- *in which transmitting the survey question comprises: determining that the player is losing; and transmitting the survey question in response to determining that the player is losing.*

2.3.1. The References Do Not Disclose All the Limitations of Group B

Appellants respectfully submit that none of the claims of Group B is obvious in light of any combination of the evidence cited (Raven and Plainfield).

First, no combination of the subject matter described in Raven and Plainfield teaches or suggests that it was known to select a player based on an amount lost gambling by the player or to determine that a player is losing. Second, there is no suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to modify or to combine any teachings of the cited references to provide for such subject matter. The Examiner has failed to properly support, with objective and substantial evidence of record, the findings on which the rejection is based, and thus has failed to establish a prima facie case of obviousness.

Examiner's Findings

The Examiner asserts:

Regarding claims 75, 76, 99, 102, 103, it would have been obvious to one of ordinary skill at the time of the invention to have selected any type of player, including losing players, for rewarding participation in a data gathering survey, so that the survey data could be collected for

any type of targeted segment or so the reward for survey participation may be offered to those who are losing in order to keep their spirits up.

[Fifth Office Action, page 3]. No evidence is offered in support of this conclusory finding.

The Examiner further asserts:

Applicant argues that the references do not teach selecting a player based upon a losing gambling history. As pointed out, Raven et al teaches identification of players as well as special treatment for certain players. It would have been obvious to one of ordinary skill at the time of the invention to have transmitted the disclosed interactive questions (taken to meet the broad language of a survey) to any desired individual or type of individual, including losing players.

[Fifth Office Action, page 6].

Examiner's Findings Not Supported by Substantial Evidence of Record

The Examiner's findings are the epitome of the conclusory findings that are not supported by any evidence of record and that the Board will not accept.

For the purpose of clarifying the record, Appellants note that Claim 76 does not require that a player is a "losing player," but explicitly requires only that a player is selected based on an amount lost gambling. Appellants also note that Claim 99 does not require that a player has an overall history of losing, only that a survey question is transmitted in response to determining that the player is losing.

As discussed above with respect to Group A, there is no suggestion in the record of selecting particular people for receiving questions or compensation, how "any type of player" could be selected (much less "losing players"), or "targeted segments." The mere fact that "special players" are mentioned in Raven and presenting survey questions is mentioned in Plainfield is not substantial evidence of the Examiner's assertion that it was known to target particular individuals for data collection. The Examiner's mere conclusion defies the evidence of record—

nothing made of record remotely hints at selecting a player based on gambling history, much less on an amount lost gambling; or transmitting a survey question in response to determining that a player is losing.

In fact, the Examiner has failed to identify in the record evidence of determining a player is losing, an amount lost gambling by a player, or even any subject matter related to a player losing or an amount lost gambling by a player. Even if the evidence relied upon by the Examiner suggested identifying a player to receive a survey question (which Appellants dispute), nothing in that evidence suggests selecting that player based on an amount lost gambling or transmitting a question in response to determining the player is losing. The rejection of Group B fails for at least this reason.

The Examiner concedes that Raven is limited to identifying only “certain players” for “special treatment” by “casino personnel.” [Fifth Office Action, page 6]. Despite the fact that Raven is limited to what it actually discloses, the Examiner continues to rely on the generalized and baseless theory that this “special treatment” by “casino personnel” of “certain players” would have suggested to one of ordinary skill in the art that it is obvious to identify a player specifically based on whether the player is losing or the amount lost gambling by the player, and further that it would be obvious to provide that identified player with an “interactive question” (even though the “special treatment” described in Raven does not remotely contemplate questioning the “certain players”).

The Examiner’s findings are conclusory, have no objective evidentiary basis, have not been established as being made from the viewpoint of one having an ordinary level of skill in the art at the time of the invention, and cannot support a prima facie case of obviousness.

The Examiner has failed to establish a prima facie case of obviousness of Group B for at least these reasons.

2.3.2. No motivation to combine the Raven and Plainfield references

As discussed above with respect to Group A, there is no evidence of record that it would have been obvious to combine Raven and Plainfield.

The references are not analogous. There is also no reasoned finding by the Examiner supported by objective evidence that explains why it would have been desirable to determine the amount lost gambling by a player or to select a player to receive a survey question based on that amount lost gambling.

Examiner's Findings

The Examiner's findings with respect to Group B are discussed above.

Examiner's Findings Not Supported by Substantial Evidence of Record

There is no evidence of record that it would have been obvious to one of ordinary skill in the art to modify the Raven system to provide for selecting a player to receive a survey question based on the gambling history of the player, much less based on an amount lost gambling by the player; or to transmit a question in response to determining that a player is losing. The Examiner's finding is convenient for the Examiner's rejection but has no evidentiary basis. The Examiner does not even attempt to establish evidence that it was known to consider whether a player is losing or the amount lost gambling by a player for any purpose, much less that it was known to select a player to receive a survey question based on the amount lost or transmit a question in response to determining the player is losing. The mere fact that "special players" are mentioned in Raven and presenting survey questions is mentioned in Plainfield is not substantial evidence of the asserted motivation(s).

Also, as discussed with respect to Group A, there is no evidence in support of the Examiner's finding that "the reward for survey participation may be offered to those who are losing in order to keep their spirits up" was known at the time of invention. Further, there is no finding of the level of ordinary skill, so there is no objective evidence supporting the Examiner's finding that the asserted subject matter would have been known or that the proposed combination of teachings of Raven and Plainfield would have been deemed desirable by one of only ordinary skill before the time of invention. The Examiner has made a conclusory, subjective, and impermissible finding using the benefit of Appellants' disclosure, a finding that cannot be supported by any objective evidence of record.

The Examiner has failed to establish a *prima facie* case of obviousness of Group B for at least these reasons.

Accordingly, Appellants respectfully request reconsideration of the § 103(a) rejections of Group B.

2.4. Group C: Claims 102 and 103

Group C includes Claims 102 and 103.

Claim 102 depends from independent Claim 75 and Claim 102 depends from Claim 102. Thus all of the arguments discussed above with respect to Claim 75 and Group A are equally applicable to Group C. Arguments presented with respect to Claim 102 are equally applicable to the other claims of Group C.

Substantial evidence is required of all factual findings. In re Gartside, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000). Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group C is flawed because the Examiner has not made a *prima facie* case of obviousness.

The Examiner has failed to provide substantial evidence that all of the features of Claim 102 were known at the time of invention. The Examiner has also failed to provide substantial evidence of a motivation to combine or modify the asserted subject matter to provide for such a feature.

Further, even if the evidence of record supported the Examiner's purported motivation to combine asserted subject matter in the manner suggested, the resulting combination would fail to teach or suggest all of the specific features of Claim 102. Any combination or modification of the references relied upon would fail to teach or suggest Claim 102.

There is no *prima facie* showing of obviousness of any claim of Group C. At least one limitation is not disclosed or suggested by the cited references. Accordingly, the Examiner has not presented a *prima facie* case of obviousness of the claims. Further, no claim of Group C is obvious in light of the evidence relied upon by the Examiner.

In addition to the failures outlined above with respect to the rejection of Group A, the Raven and Plainfield references do not provide evidence that the following feature was known:

- *generating an offer to the player based on the gambling history.*

2.4.1. The References Do Not Disclose All the Limitations of Group C

Appellants respectfully submit that none of the claims of Group C is obvious in light of any combination of the evidence cited (Raven and Plainfield).

First, no combination of the subject matter described in Raven and Plainfield teaches or suggests that generating an offer to a player has anything to do with gambling history of the player. Second, there is no suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to modify or to combine any teachings of the cited references to provide for such subject matter. The Examiner has failed to properly support, with objective and substantial evidence of record, the findings on which the rejection is based, and thus has failed to establish a prima facie case of obviousness.

The Raven and Plainfield references do not provide any evidence of:
generating an offer to the player based on the gambling history.

The Examiner has not provided evidence that could support his finding that it was known or desirable to select a player to receive a survey question via a slot machine based on any information about the player (much less gambling history).

Examiner's Findings

The Examiner asserts:

Regarding claims 75, 76, 99, 102, 103, it would have been obvious to one of ordinary skill at the time of the invention to have selected any

type of player, including losing players, for rewarding participation in a data gathering survey, so that the survey data could be collected for any type of targeted segment or so the reward for survey participation may be offered to those who are losing in order to keep their spirits up. The reward-based survey itself can be taken to be an offer.

[Fifth Office Action, page 3 (emphasis added)]. No evidence is offered in support of this conclusory finding. Appellants understand that the underlined quoted sentence is directed to Claims 102 and 103, which recite *an offer*.

Examiner's Findings Not Supported by Substantial Evidence of Record

The Examiner's findings are the epitome of the conclusory findings that are not supported by any evidence of record and that the Board is not permitted to accept.

The Examiner simply concludes: "The reward-based survey itself can be taken to be an offer." Even if this were true, there is nothing in Raven or Plainfield that would suggest *generating an offer to the player based on the gambling history*, as recited in Claim 102.

As discussed above with respect to Group A, there is no suggestion in the record of selecting particular people for receiving questions or compensation, how "any type of player" could be selected (much less "losing players"), or "targeted segments." The mere fact that "special players" are mentioned in Raven and presenting survey questions is mentioned in Plainfield is not substantial evidence of the Examiner's assertion that it was known to target particular individuals for data collection. The Examiner's mere conclusion defies the evidence of record—nothing made of record remotely hints at selecting a player based on gambling history, much less generating an offer for the player based on the gambling history. Also, as discussed with respect to Group A, there is also no evidence in support of the Examiner's finding that "the reward for survey participation may be offered to

those who are losing in order to keep their spirits up” was known at the time of invention. Further, there is no finding of the level of ordinary skill, so there is no objective evidence supporting the Examiner’s finding that the asserted subject matter would have been known or that the proposed combination of teachings of Raven and Plainfield would have been deemed desirable by one of only ordinary skill before the time of invention.

The Examiner has failed to establish a prima facie case of obviousness of Group C for at least these reasons.

2.4.2. No motivation to combine the Raven and Plainfield references

As discussed above with respect to Group A, there is no evidence of record that it would have been obvious to combine Raven and Plainfield.

The references are not analogous. There is also no reasoned finding by the Examiner supported by objective evidence that explains why it would have been desirable to generate an offer for a player based on the gambling history of the player.

Examiner’s Findings

The Examiner’s findings with respect to Claim 102 are discussed above.

Examiner’s Findings Not Supported by Substantial Evidence of Record

The failure of the Examiner to support, with objective evidence of record, the finding of a motivation to modify the Raven system to provide for a “reward-based survey” is discussed above.

Further, there is no evidence of record that it would have been obvious to one of ordinary skill in the art to modify the Raven system to provide for generating an offer for a player based on the gambling history of the player. This

finding is convenient for the Examiner's rejection but has no evidentiary basis. The Examiner does not even attempt to establish evidence that it was known to generate an offer based on gambling history of a player. The mere fact that "special players" are mentioned in Raven and presenting survey questions is mentioned in Plainfield is not substantial evidence of the asserted motivation(s).

There is also no evidence in support of the Examiner's finding that "the reward for survey participation may be offered to those who are losing in order to keep their spirits up" was a known motivation at the time of invention. The Examiner has made a conclusory, subjective, and impermissible finding using the benefit of Appellants' disclosure, a finding that cannot be supported by any objective evidence of record.

The Examiner has failed to establish a *prima facie* case of obviousness of Group C for at least these reasons.

Accordingly, Appellants respectfully request reconsideration of the § 103(a) rejections of Group C.

2.5. Group D: Claims 79 and 80

Group D includes Claims 79 and 80.

Each of Claims 79 and 80 depends from independent Claim 75. Thus all of the arguments discussed above with respect to Claim 75 and Group A are equally applicable to Group D.

Substantial evidence is required of all factual findings. *In re Gartside*, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000). Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group D is flawed because the Examiner has not made a *prima facie* case of obviousness.

The Examiner has failed to provide substantial evidence that all of the features of Group D were known at the time of invention. The Examiner has also failed to provide substantial evidence of a motivation to combine or modify the asserted subject matter to provide for such a feature.

Further, even if the evidence of record supported the Examiner's purported motivation to combine asserted subject matter in the manner suggested, the resulting combination would fail to teach or suggest all of the specific features of Group D. Any combination or modification of the references relied upon would fail to teach or suggest Group D.

There is no *prima facie* showing of obviousness of any claim of Group D. At least one limitation is not disclosed or suggested by the cited references. Accordingly, the Examiner has not presented a *prima facie* case of obviousness of the claims. Further, no claim of Group D is obvious in light of the evidence relied upon by the Examiner.

Examiner's Findings

The Examiner asserts: “the reward can be viewed by the player as ‘offsetting or ‘erasing’ a loss.” [Fifth Office Action, page 3].

The Examiner asserts:

Applicant argues that claims 79 and 80 require offsetting or erasing a loss. The compensation for answering questions can meet both of those requirements. Whether a reward (regardless of how small) offsets/erases a loss (regardless of how large) is largely up to the player's interpretation. Applicant's method and apparatus claims set forth method steps and structure configured to carry out the method steps. Claim language that describes a player's feelings or reactions to the instant invention (does this small reward offset my losses) does not define applicant's claimed inventive method steps or apparatus. Nonetheless, the examiner has demonstrated how the proposed rejection would read on such language. Further still, the free credits as proposed by the examiner also rewards [sic—reads?] on offsetting and erasing a gambling loss.

[Fifth Office Action, page 7].

Examiner's Findings Not Supported by Substantial Evidence of Record

The Examiner does not and cannot point to any support in the record for the assertion that it would have been known at the time of the invention that “[w]hether a reward (regardless of how small) offsets/erases a loss (regardless of how large) is largely up to the player's interpretation.” This is clearly the Examiner's subjective belief made at the time the Office Action was authored. There is still no support in the record for any assertion as to how a player might view compensation for responding to a survey question, and no evidence of record that one having only ordinary skill in the art would have known compensation for a survey question response could have anything to do specifically with a gambling loss. The Examiner has failed to establish a prima facie case of obviousness of Claims 79 and 80 for at least this reason.

Regardless, the Examiner also appears to have misread the claims. Nothing in Claim 79 or 80 suggests or requires that a player interpret anything. Instead, the claims specifically recite that the *compensation comprises offsetting a gambling loss of the player* (Claim 79) or *compensation comprises erasing a gambling loss of the player* (Claim 80). Thus, irrespective of a “player’s feelings or reactions,” Claims 79 and 80 require offsetting or erasing of a gambling loss. Nothing in the cited evidence remotely suggests that compensation for a response to a survey question would comprise anything related to a gambling loss of a player, much less would comprise actually offsetting or erasing that gambling loss, or the desirability of providing for such subject matter.

Further, contrary to the Examiner’s assertion, nothing in the cited references suggests any type of “compensation for answering questions” that will specifically offset or erase a determined gambling loss.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness for Group D.

3. Section 103(a)—Raven + Plainfield + Examiner’s Subjective Belief

Claims 86, 94, 95, 100, 101, and 105 stand rejected under 35 U.S.C. 103(a) as being obvious in view of:

(i) asserted subject matter allegedly supported by evidence from:

Raven, and

Plainfield; and

(ii) asserted subject matter

(a) that is not supported by substantial evidence of record,

(b) that the Examiner now acknowledges is not supported by evidence of record, and

(c) that the Examiner now explicitly states does not have to be supported by any evidence of record.

The Examiner’s Section 103(a) rejections based on the above grounds are argued separately for the following Groups of appealed claims:

Group E. Claims 86, 94, and 95

Group F. Claims 100 and 101

Group G. Claim 105

The claims in the different designated groups do not stand and fall together. Each of the groups is addressed below under a separate subheading identifying the respective claim(s) by number.

3.1. Group E: Claims 86, 94, and 95

Group E includes Claims 86, 94, and 957.

Each of Claims 86, 94, and 95 depends from independent Claim 75. Thus all of the arguments discussed above with respect to Claim 75 and Group A are equally applicable to Group E.

Substantial evidence is required of all factual findings. In re Gartside, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000). Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group E is flawed because the Examiner has not made a *prima facie* case of obviousness.

The Examiner has failed to provide substantial evidence that all of the features of Group E were known at the time of invention. The Examiner has also failed to provide substantial evidence of a motivation to combine or modify the asserted subject matter to provide for such a feature.

The Examiner has explicitly relied upon findings that the Examiner admits are not supported by evidence of record. The Examiner has further expressed an erroneous belief that not all findings on which an obviousness rejection are based need to be supported by substantial evidence made of record. Cf. In re Gartside; In re Lee; Zurko; In re Fritch; In re Kotzab; In re Fine.

There is no *prima facie* showing of obviousness of any claim of Group E. At least one limitation is not disclosed or suggested by the cited references. Accordingly, the Examiner has not presented a *prima facie* case of obviousness of the claims. Further, no claim of Group E is obvious in light of the evidence relied upon by the Examiner.

Examiner's Findings

With respect to all of Claims 86, 94, and 95, the Examiner still takes Official Notice that it was known that “casinos ‘comp’ players with free plays/tokens, credits, cash, reduced rates, free rooms and to manipulate the prize tables, activate additional paylines/reels in order to increase the players chance of winning...”

During the Telephone Interview held on January 11, 2005, with our representative, our representative noted that some of the Examiner’s Section 103(a)

rejections (e.g., for Claims 86, 94, and 95) rely on unsupported Official Notice. The Examiner agreed during the Telephone Interview to provide references supporting the asserted subject matter. [Amendment and Response mailed March 21, 2005, page 9].

Examiner's Findings Not Supported by Substantial Evidence of Record

Despite the Examiner's early indication (during the Telephone Interview) that he would do so, the Examiner still does not indicate any support for any of the subject matter for which the Examiner simply takes "Official Notice."

The Examiner has simply repeated the rejections of Claims 86, 94, and 95 as being based on "Official Notice" of asserted subject matter. [Fifth Office Action, page 4]. The Examiner is still unable or unwilling to provide an evidentiary basis for the assertions on the record.

Appellants are grateful that the Examiner has clarified the Examiner's (mis)understanding of the law regarding how a prima facie case of obviousness must be established. The Examiner clearly believes that the Examiner does not have to support all factual findings with substantial evidence of record:

Applicant argues that the Examiner does not provide support or evidence for the Official Notices taken; this is the nature of taking Official Notice. Examiner believes these assertions are well known. [Fifth Office Action, page 6]. The Examiner thus admits to an erroneous belief that an Examiner can merely label a factual assertion as "Official Notice" in order to be exempt from the precedential authority that puts the burden on the Examiner to indicate the substantial and objective evidence of record that is the basis for that finding. Thus, contrary to law, the Examiner explicitly admits that the rejections of at least Claims 86, 94, and 95 rest on the Examiner's subjective belief that the subject matter of the Official Notices is "well known" and explicitly admits to a

belief that the Examiner does not have to provide particular objective evidence of record to support the factual findings. Cf. In re Gartside; In re Lee; Zurko.

The Examiner further asserts:

Applicant is free to seasonably challenge this taking of Official Notice, yet applicant is not believed to have properly challenged the Official Notice(s) taken.

[Fifth Office Action, page 8].

Appellants have specifically pointed out a fatal deficiency in the Examiner's rejections of Claims 86, 94, and 95, namely that the Examiner has failed to establish a *prima facie* case of obviousness by failing to provide substantial evidence supporting some of the asserted subject matter on which the rejections are based (the "Official Notice"). Appellants requested that the Examiner make any such evidence (if found) of record. The propriety of a request that references be made available in support of the taking of "Official Notice" is outlined in MPEP § 2144.03.

Appellants timely (and repeatedly) responded to the rejections and argued that the Examiner had failed to establish a *prima facie* case of obviousness for failure to indicate substantial evidence in support of the asserted subject matter of the Official Notice. There is no such evidence of record; the Examiner admits as much by asserting the belief that it does not need to be provided for "Official Notice." The Examiner has thus not established a *prima facie* case of rejection for any of Claims 86, 94, and 95. Appellants are thus not under any obligation to address those assertions the Examiner admits are based only on his own subjective belief and for which no evidence has been made of record, because they cannot be relied upon to establish a *prima facie* case. See In re Oetiker.

The cited references do not support the Examiner's broad assertions as to what was well known; the Examiner does not assert otherwise. No references have

been provided for any of the Examiner's general assertions. Given that the only particular information in the record thus far regarding what is considered to be in the prior art is the Examiner's brief statement, Appellants cannot properly determine the bounds of the prior art on which the rejections are based. Accordingly, Appellants dispute that the subject matter asserted was "well known" at the time the invention was made, and request, for each of Claims 86, 94, and 95, a reference to clarify the subject matter in more detail. MPEP 2144.03.

The Examiner's sweeping assertions cannot be used as prior art to the present application – only the content of the references of record which are prior art to the present application may so used. "[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

Further, subject matter without an evidentiary basis cannot be used as the basis for a rejection under 102 or 103. Official Notice may be used, if at all, only to clarify the meaning of a reference. See, e.g., *In re Ahlert*, 424 F.2d 1088 (C.C.P.A. 1969) ("Typically, it is found necessary to take notice of facts which may be used to supplement or **clarify the teaching of a reference** disclosure, perhaps to justify or explain a particular inference to be drawn **from the reference teaching.**") (emphasis added).

There is still no evidence of record that compensation provided via a slot machine for a response comprising any of the following would have been known to one having ordinary skill in the art:

an insurance protection against a loss (Claim 86)

allowing the player to receive a prize corresponding to an outcome on an inactive payline (Claim 94)

retroactively activating a payroll in exchange for gambling plays (Claim 95)

No substantial evidence of any of this subject matter has been made of record, even after the Examiner was requested to do so. See Applicant's Third Response. Appellants again traverse the Examiner's "Official Notice" and any other unsupported assertions as to what features or motivations would have been known to one of ordinary skill in the art.

The Examiner has further failed to provide any evidence that if such subject matter was known it would have been obvious to modify the Raven system to provide for the asserted types of compensation. The Examiner has apparently based the rejections of Claims 86, 94, and 95 on the legally flawed reasoning that if subject matter was merely known, that is enough to establish a *prima facie* case of obviousness. The Examiner has failed to establish, by substantial and objective evidence, a suggestion either in the prior art references or in the knowledge of one having ordinary skill in the art that it would have been obvious to make the specific modifications proposed by the Examiner.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness for any of Claims Group E.

3.2. Group F: Claims 100 and 101

Group F includes Claims 100 and 101.

Each of Claims 100 and 101 depends from independent Claim 75. Thus all of the arguments discussed above with respect to Claim 75 and Group A are equally applicable to Group F.

Substantial evidence is required of all factual findings. In re Gartside, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000). Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group F is flawed because the Examiner has not made a *prima facie* case of obviousness.

The Examiner has failed to provide substantial evidence that all of the features of Group F were known at the time of invention. The Examiner has also failed to provide substantial evidence of a motivation to combine or modify the asserted subject matter to provide for such a feature.

The Examiner has explicitly relied upon findings that the Examiner admits are not supported by evidence of record. The Examiner has further expressed an erroneous belief that not all findings on which an obviousness rejection are based need to be supported by substantial evidence made of record. Cf. In re Gartside; In re Lee; Zurko; In re Fritch; In re Fine.

There is no *prima facie* showing of obviousness of any claim of Group F. At least one limitation is not disclosed or suggested by the cited references. Accordingly, the Examiner has not presented a *prima facie* case of obviousness of the claims. Further, no claim of Group F is obvious in light of the evidence relied upon by the Examiner.

Examiner's Findings

The Examiner asserts:

Regarding claims 100, 101, it would have been obvious to one of ordinary skill at the time of the invention to have provided the survey question(s) at any time where it can be detected that a player is present such as when the reels are spinning, when a card is swiped or when a coin is deposited. All are obvious methods of determining whether a player is present. Further, applicant's claiming of various triggers to send the question is evidence of a lack of criticality regarding such triggers.

[Fifth Office Action, page 4].

Examiner's Findings Not Supported by Substantial Evidence of Record

The Examiner's rejection of Group F is not supported by the record.

There is no support in the record for the Examiner's generalized conclusion that it would have been obvious "to have provided the survey question(s) at any time where it can be detected that a player is present such as when the reels are spinning, when a card is swiped or when a coin is deposited. All are obvious methods of determining whether a player is present." This is the epitome of an unsupported finding of obviousness based on the Examiner's use of impermissible hindsight to simply assert that the specific claimed features would have been obvious. There is no support in the record for the finding that the subject matter is "obvious methods of determining whether a player is present." Even if that were true (which Appellants submit is not supported by the record), that does not provide substantial evidence that it would have been obvious to transmit a survey question to a slot machine in response to the particular determinations. The Examiner has not and cannot point to any portion of the record in support of the rejections of Group F. Specifically, there is no suggestion of providing survey questions during a gambling session, much less that it is desirable to provide

survey questions at any particular time, much less based on the particular determinations in the claims.

The Examiner appears to hold an erroneous belief that an Examiner can merely label a factual assertion as “obvious” in order to be exempt from the precedential authority that puts the burden on the Examiner to indicate the substantial and objective evidence of record that is the basis for that finding. Thus, contrary to law, the rejections of Group F appear to rest on the Examiner’s subjective belief that “All are obvious methods of determining whether a player is present.” The Examiner effectively admits to a belief that the Examiner does not have to provide particular objective evidence of record to support the factual findings. Cf. In re Gartside; In re Lee; Zurko.

Appellants previously specifically pointed out a fatal deficiency in the Examiner’s rejections of Claims 100 and 101, namely that the Examiner has failed to establish a prima facie case of obviousness by failing to provide substantial evidence supporting some of the asserted subject matter on which the rejections are based. Appellants requested that the Examiner make any such evidence (if found) of record. The Examiner has still not provided any evidence of the asserted subject matter.

The burden on the Examiner requires the Examiner to establish substantial evidence that all of the claimed subject matter was known and that there was a teaching, suggestion, or inference known at the time of invention to combine asserted teachings in the manner proposed by the Examiner.

The cited references do not support the Examiner’s broad assertions as to what was allegedly “obvious”; the Examiner does not assert otherwise. No references have been provided for any of the Examiner’s general assertions. Given that the only particular information in the record thus far regarding what is considered to be in the prior art is the Examiner’s brief statement, Appellants

cannot properly determine the bounds of the prior art on which the rejections are based. Accordingly, Appellants dispute that the subject matter asserted was “obvious” at the time the invention was made, and request, for each of Claims 82-97, a reference to clarify the subject matter in more detail. MPEP 2144.03.

The Examiner's sweeping assertions cannot be used as prior art to the present application – only the content of the references of record which are prior art to the present application may so used. “[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'” In re Zurko, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). Subject matter without an evidentiary basis cannot be used as the basis for a rejection under 102 or 103.

The Examiner further asserts:

Further, applicant's claiming of various triggers to send the question is evidence of a lack of criticality regarding such triggers.

[Fifth Office Action, page 4]. Appellants do not understand the Examiner's statement. Appellants have never stated that any of the claimed subject matter of Group F is “critical.” No objective evidence (other than Appellants' own claims) are indicated as supporting the statement. The Examiner might be expressing a belief that because two different types of determinations for transmitting a survey question are claimed, that is somehow evidence that the claimed embodiments are obvious in light of each other, or that the additional limitations of Group F are not real limitations (and thus unworthy of a proper prima facie rejection) because they somehow lack “criticality.” These are not proper reason to reject Group F. Appellants request the precedential authority (if any) supporting the use of the Examiner's unsupported finding of “lack of criticality” based only on Appellants' own claims as a basis for establishing a prima facie obviousness rejection. Where

the record is devoid of any evidence of transmitting a survey question in response to the specific determinations recited and the Examiner has failed to establish a prima facie case, Appellants do not need to distinguish the claimed subject matter over anything or to establish unexpected results or other indicia of non-obviousness. See In re Oetiker.

Nothing in Raven or Plainfield teaches or suggests in which transmitting a survey question comprises any of:

determining that a reel of the slot machine is spinning; and
transmitting the survey question in response to determining that the reel of the slot machine is spinning
as recited in Claim 100; or

determining that a coin is dropping at the slot machine; and
transmitting the survey question in response to determining that the coin is dropping at the slot machine
as recited in Claim 101.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness for any claim of Group F.

3.3. Group G: Claim 105

Group G includes Claim 105.

Claim 105 depends from independent Claim 75. Thus all of the arguments discussed above with respect to Claim 75 and Group A are equally applicable to Group G.

Substantial evidence is required of all factual findings. *In re Gartside*, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000). Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group G is flawed because the Examiner has not made a *prima facie* case of obviousness.

The Examiner has failed to provide substantial evidence that all of the features of Group G were known at the time of invention. The Examiner has also failed to provide substantial evidence of a motivation to combine or modify the asserted subject matter to provide for such a feature.

There is no *prima facie* showing of obviousness of any claim of Group G. At least one limitation is not disclosed or suggested by the cited references. Accordingly, the Examiner has not presented a *prima facie* case of obviousness of the claims. Further, no claim of Group G is obvious in light of the evidence relied upon by the Examiner.

Examiner's Findings

The Examiner asserts:

Regarding Claim 105, any response is taken to be a commitment for providing truthful answers.

[Fifth Office Action, page 4]. No support is indicated as evidence that one of ordinary skill in the art would have had this understanding at the time of the invention.

Examiner's Findings Not Supported by Substantial Evidence of Record

Despite Appellants' prior request for the Examiner to provide evidence of the asserted subject matter, the Examiner still does not even attempt to indicate that the above assertion on which the rejection of Group G is based is supported by the record. Raven and Plainfield cannot support the assertion; the Examiner does not assert otherwise.

There is no substantial evidence of record supporting the Examiner's assertion or suggesting *a response comprising a commitment*, as generally recited Claim 105. Raven and Plainfield cannot support the finding. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness with respect to Claim 105.

4. Section 103(a)—Raven + Plainfield + Liverance

4.1. Group H: Claims 76, 77, 78, 84, 102, and 103

Claims 76, 77, 78, 84, 102, and 103 stand rejected under 35 U.S.C. 103(a) as being obvious in view of asserted subject matter allegedly supported by evidence from:

Raven,

Plainfield, and

U.S. Patent No. 5,971,850 issued to Liverance (“Liverance”).

All of Claims 76, 77, 78, 84, 102, and 103 depend from Claim 75 and thus the arguments provided above with respect to Group A are equally applicable to Claims 76, 77, 78, 84, 102, and 103.

The Examiner asserts:

Liverance teaches that the slot machine can adapt and make the chance for success easier if the player is losing in order to optimize the player's interest in the game and sustain the time played at the machine [2:24-64]. It would have been obvious to one of ordinary skill at the time of the invention to have targeted losing players of Raven et al and offered them opportunities to complete surveys in order to increase their chances of future winning if they participate and continue playing. Regarding claim 77, Raven et al teaches that entire player histories (i.e. plural sessions) are tracked. Regarding claim 78, any amount losing can be said to be above a threshold of \$0.00. The reward-based survey itself can be taken to be an offer.

[Fifth Office Action, pages 4-5].

Appellants traverse this assertion. As discussed above, there is no suggestion in the cited references of targeting losing players to receive survey questions.

As discussed above with respect to Groups A and B, nothing in any of the cited references hints at transmitting a survey question to a player selected by determining an amount lost gambling by the player, or transmitting a survey question to a player who is losing. Nothing in any of the cited references hints at transmitting a survey question to a player selected if the amount lost gambling is not less than a predetermined amount greater than zero, as recited in Claim 78. The Examiner simply asserts that “any amount losing can be said to be above a threshold of \$0.00” without indicating any evidence of record supporting the finding that it would have been obvious to modify the Raven system to transmit a survey question to a player selected in the recited manner.

Also, if, as the Examiner contends, Liverance is directed to a system for sustaining the time played at the machine or optimizing the player’s interest in the game, it is not clear why this would suggest the desirability of offering “them opportunities to complete surveys,” as the modification of Raven proposed by the Examiner would appear to interrupt the very play that Liverance wants to extend. The Liverance solution is to make the player more likely to win, not interact with the player, much less provide a survey. Thus, the evidence on which the Examiner relies for the proposed combination of subject matter would in fact seem to teach away from that combination. The Examiner must take into account evidence that detracts from the obviousness conclusion. The Examiner’s combination of Raven, Plainfield and Liverance clearly relies impermissibly on Appellants’ disclosure as a roadmap for identifying discrete teachings in the prior art without substantial evidence of a motivation for combining such teachings.

Nothing in Raven, Plainfield or Liverance hints at a feature in which the determined compensation for a response to a survey question comprises an increase in odds of winning in a game of chance, as recited in Claim 84.

Contrary to the Examiner's unsupported assertion, as discussed above with respect to Group C, nothing in the cited references teaches or suggests *generating an offer* based on anything, much less *based on the gambling history of the player*, as recited in Claims 102 and 103. Liverance does not suggest generating an offer or otherwise support the Examiner's rejection of any claim of Group H.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of any of Group H.

5. Section 103(a)—Raven + Plainfield + Paige

5.1. Group I: Claim 98

Claim 98 stands rejected under 35 U.S.C. 103(a) as being obvious in view of asserted subject matter allegedly supported by evidence from:

Raven,

Plainfield, and

U.S. Patent No. 5,941,772 issued to Paige (“Paige”).

Claim 98 depends from Claim 75 and thus the arguments provided above with respect to Group A are equally applicable to Group I.

The Examiner asserts:

Paige teaches putting ad logos on slot reels. It would have been obvious to one of ordinary skill at the time of the invention to have provided such ad-enhanced reels with the systems of Raven et al and Plainfield et al in order to exploit the player's gambling attention for advertising revenue. In the obvious case of providing free points/credits/plays, the compensation is taken to be allowing the player to watch and play the ad-enhanced reels.

[Fifth Office Action, page 5]. Appellants do not understand these assertions.

Contrary to the Examiner's implication, Paige is devoid of any hint that logos are related to compensation to a player. Further, it is not clear what the Examiner believes this would have to do with “allowing the player to watch and play the ad-enhanced reels,” or how exploiting “the player's gambling attention” would have been considered compensation for the player. The Examiner has not provided any evidence that “providing ad-enhanced reels” would have been understood by one of only ordinary skill in the art as suggesting compensation for a player, much less compensation for the player responding to a survey question.

Without any evidence in support of a finding of a level of ordinary skill, or in support of a finding that one of ordinary skill would have considered watching and playing of “ad-enhanced reels” as compensation for anything (much less for a response to a survey question transmitted via a slot machine), the Examiner has failed to establish a *prima facie* case of obviousness of Group I.

Nothing in the evidence of record (including Paige) suggests a motivation known to one of ordinary skill in the art to modify the Raven system to provide compensation comprising *placing an advertising logo on a payline of the slot machine*. The Examiner’s rejection of Group I fails for at least this reason.

The Examiner has also not provided any evidence of why it would have been obvious, even if “free points/credits/plays” were known, to place *an advertising logo on a payline of the slot machine*. The Examiner’s rejection of Group I fails for at least this reason.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness with respect to Group I.

6. Section 103(a)—Raven + Plainfield + Dyer

6.1. Group J: Claim 104

Claim 104 stands rejected under 35 U.S.C. 103(a) as being obvious in view of asserted subject matter allegedly supported by evidence from:

Raven,

Plainfield, and

U.S. Patent No. 5,090,734 issued to Dyer (“Dyer”).

Claim 104 depends from Claim 75 and thus the arguments provided above with respect to Group A are equally applicable to Group J.

Substantial evidence is required of all factual findings. In re Gartside, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000). Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group J is flawed because the Examiner has not made a *prima facie* case of obviousness.

The Examiner has failed to provide substantial evidence that all of the features of Claim 104 were known at the time of invention. The Examiner has also failed to provide substantial evidence of a motivation to combine or modify the asserted subject matter to provide for such a feature.

Further, even if the evidence of record supported the Examiner’s purported motivation to combine asserted subject matter in the manner suggested, the resulting combination would fail to teach or suggest all of the specific features of Claim 104. Any combination or modification of the references relied upon would fail to teach or suggest Claim 104.

There is no *prima facie* showing of obviousness of any claim of Group J. At least one limitation is not disclosed or suggested by the cited references.

Accordingly, the Examiner has not presented a *prima facie* case of obviousness of the claims. Further, no claim of Group J is obvious in light of the evidence relied upon by the Examiner.

In addition to the failures outlined above with respect to the rejection of Group A, the Raven, Dyer, and Plainfield references do not provide evidence that it would have been obvious to provide for the claimed subject matter as a whole, which includes the features of:

- *displaying an advertisement to the player via the slot machine, and*
- *in which the survey question is about the advertisement.*

Examiner's Findings

The Examiner asserts:

Dyer teaches presenting an advertisement to a user and collecting answers from the user regarding questions about the product ad. It would have been obvious to one of ordinary skill at the time of the invention to have collected such marketing information with the system of Raven et al/Plainfield et al in order to gather advertising and product information from casino customers.

[Fifth Office Action, pages 5-6].

Examiner's Findings Not Supported by Substantial Evidence of Record

Contrary to the Examiner's assertion, there is no evidence of record that it would have been obvious "to gather advertising and product information from casino customers." The Examiner makes the generalized and convenient conclusion that because of the teachings of Dyer it must therefore have been obvious to modify a casino-based system such as Raven to provide for displaying an advertisement to the player via the slot machine. Nothing of record supports the existence of such a motivation at the time of the invention.

The Examiner's statement therefore amounts to no more than a conclusion of generalized advantage and a convenient assumption about what was allegedly known to those of ordinary skill in the art. Nothing in Dyer or in the cited references suggests the desirability of modifying Raven or Plainfield in the manner suggested by the Examiner.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness with respect to Group J.

CONCLUSION

Thus, the Examiner's rejection of the pending claims is improper at least because the Examiner has not provided a proper legal basis for rejecting any claim. Therefore, Appellants respectfully request that the Examiner's rejections be reversed.

If any issues remain, or if there are any further suggestions for expediting allowance of the present application, please contact Appellants' representative using the information provided below.

Appellants hereby request any extension of time that may be required to make this Appeal Brief timely. Please charge any fees that may be required for this paper, or credit any overpayment, to Deposit Account No. 50-0271.

Respectfully submitted,

November 3, 2006

Date

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APPENDIX A—CLAIMS INVOLVED IN THE APPEAL

Claims 75-108 are being appealed.

Appealed Claims 75, 107, and 108 are independent.

75. A method comprising:
determining a gambling history of a player;
selecting the player to receive a survey question based on the gambling history;
transmitting the survey question to the player via a slot machine;
receiving a response of the player to the survey question;
determining, by a processing device, compensation for the response; and
after receiving the response, transmitting a signal to the slot machine to provide the determined compensation to the player.

76. The method of claim 75, in which selecting the player comprises:
determining an amount lost gambling by the player; and
selecting the player based on the amount lost gambling.

77. The method of claim 76, in which determining the amount lost gambling by the player comprises:
determining an amount lost gambling by the player over a plurality of gambling sessions.

78. The method of claim 76, in which selecting the player based on the amount lost gambling comprises:

selecting the player if the amount lost gambling is not less than a predetermined amount,

the predetermined amount being greater than zero.

79. The method of claim 75, in which the determined compensation comprises offsetting a gambling loss of the player.

80. The method of claim 75, in which the determined compensation comprises erasing a gambling loss of the player.

81. The method of claim 75, in which the determined compensation comprises participation in a game of chance.

82. The method of claim 75, in which the determined compensation comprises participation in a game of skill.

83. The method of claim 75, in which the determined compensation comprises a gambling token.

84. The method of claim 75, in which the determined compensation comprises an increase in odds of winning in a game of chance.

85. The method of claim 75, in which the determined compensation comprises an increased prize table.

86. The method of claim 75, in which the determined compensation comprises an insurance protection against a loss.

87. The method of claim 75, in which the determined compensation comprises an ability to play a higher denomination currency gaming machine for a lower denomination currency.

88. The method of claim 75, in which the determined compensation comprises a free use of an extra slot in a multi-slot slot machine.

89. The method of claim 75, in which the determined compensation comprises an ability to play the slot machine for free.

90. The method of claim 75, in which the determined compensation comprises an ability to have winnings rounded up to a higher level.

91. The method of claim 75, in which the determined compensation comprises a free room.

92. The method of claim 75, in which the determined compensation comprises a subsidized room.

93. The method of claim 75, in which the determined compensation comprises activating an inactive payline.

94. The method of claim 75, in which the determined compensation comprises allowing the player to receive a prize corresponding to an outcome on an inactive payline.

95. The method of claim 75, in which the determined compensation comprises retroactively activating a payline in exchange for gambling plays.

96. The method of claim 75, in which the determined compensation comprises cash.

97. The method of claim 75, in which the determined compensation comprises credit.

98. The method of claim 75, in which the determined compensation comprises placing an advertising logo on a payline of the slot machine.

99. The method of claim 75, in which transmitting the survey question comprises:
determining that the player is losing; and
transmitting the survey question in response to determining that the player is losing.

100. The method of claim 75, in which transmitting the survey question comprises:
determining that a reel of the slot machine is spinning; and
transmitting the survey question in response to determining that the reel of the slot machine is spinning.

101. The method of claim 75, in which transmitting the survey question comprises:

determining that a coin is dropping at the slot machine; and
transmitting the survey question in response to determining that the coin is dropping at the slot machine.

102. The method of claim 75, further comprising:
generating an offer to the player based on the gambling history.

103. The method of claim 102, further comprising:
presenting the offer to the player.

104. The method of claim 75, further comprising:
displaying an advertisement to the player via the slot machine, and
in which the survey question is about the advertisement.

105. The method of claim 75, in which the response comprises a commitment.

106. The method of claim 75, in which transmitting the signal comprises transmitting the signal at a time proximate to receipt of the response.

107. A computer readable medium storing instructions configured to direct a processor to perform a method comprising:

- determining a gambling history of a player;
- selecting the player to receive a survey question based on the gambling history;
- transmitting the survey question to the player via a slot machine;
- receiving a response of the player to the survey question;
- determining compensation for the response; and
- after receiving the response, transmitting a signal to the slot machine to provide the determined compensation to the player.

108. An apparatus comprising:

- a processor; and
- a computer readable medium in communication with the processor, the computer readable medium storing instructions configured to direct the processor to perform a method comprising:
 - determining a gambling history of a player;
 - selecting the player to receive a survey question based on the gambling history;
 - transmitting the survey question to the player via a slot machine;
 - receiving a response of the player to the survey question;
 - determining compensation for the response; and
 - after receiving the response, transmitting a signal to the slot machine to provide the determined compensation to the player.

APPENDIX B—EVIDENCE

<NONE>

APPENDIX C—RELATED PROCEEDINGS

<NONE>